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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/786,953 | 02/25/2004 | Allan R. Jones JR. | 1-24035 | 3792 |

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| EXAMINER | |
|---|---|
| RAGONESE, ANDREA M | |
| **ART UNIT** | **PAPER NUMBER** |
| 3743 | |

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/786,953 | JONES ET AL. | |
| | Examiner | Art Unit | |
| | Andrea M. Ragonese | 3743 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *1-4* is/are withdrawn from consideration.

5)☒ Claim(s) *7-10* is/are allowed.

6)☒ Claim(s) *5,6 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of **claims 5-11**, group II, in the reply filed on December 21, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an **election without traverse** (MPEP § 818.03(a)).

2. Therefore, **claims 1-4** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### *Response to Amendment*

3. The amendment filed on September 16, 2005 has been entered. Examiner acknowledges that **claims 7-9** have been amended. Subsequently, **claims 5-11** are under consideration, while **claims 1-4** have been withdrawn from further consideration.

### *Response to Arguments*

4. Applicant's arguments with respect to **claims 1-4** have been considered but are moot in view of the fact that Applicant has withdrawn **claims 1-4** from further consideration.

5. Applicant's arguments filed September 16, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art of record (Toffolon to US 4,971,051) was "incorrectly described in the office action in that element 4 is not a pump," the Examiner strongly disagrees. A recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In this case, Toffolon fully discloses a structural element (**4**) that is ***fully capable*** of being "manually operated" for the purpose of "delivering air to said inflatable chamber" (element **11**). Merriam-Webster OnLine defines the term "pump" as "**a device that** raises, **transfers**, or compresses **fluids** or that attenuates gases **especially by** suction or **pressure** or both" (emphasis added). Therefore, as broadly and reasonably interpreted by the Examiner, the prior art element **4** meets the claim limitation of a "pump."

Therefore, the rejection for **claim 5** under U.S.C. 102(b) is recapitulated hereinafter and made **FINAL**.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 5** and **11** are rejected under 35 U.S.C. 102(b) as being anticipated by Toffolon (US 4,971,051).

Regarding **claim 5**, Toffolon discloses a nasal mask **1** including a body having a rim, as shown in Figure 1, defining an opening adapted to receive a user's nose; a cushion **11** removably attached to said rim, said cushion having an inflatable chamber

(**that formed by 11**) extending at least partially around said rim (column 1, lines 65-68 discloses mechanical fastening which would allow for removable attachment); a manually operated pump—as broadly and reasonably interpreted by the Examiner to be balloon **4** since balloon **4** is fully capable of being manually operated by hand compressions in order to deliver air to the inflatable chamber—permanently connected to said inflatable chamber, said pump delivering air to said inflatable chamber when actuated; and a release valve **6** permanently connected to said inflatable chamber, said release valve venting air from said inflatable chamber when manually actuated (column 2, lines 35-68).

Regarding **claim 11**, Toffolon discloses a nasal mask including a body **1** having a rim, as shown in Figure 1, defining an opening adapted to receive a user's nose; a cushion assembly **11** removably attached (column 1, lines 65-68 that discloses mechanical fastening which would allow for removable attachment) to said body to extend around said rim, and wherein said cushion assembly includes an inflatable chamber (**that formed by 11**); a manually operated pump—as broadly and reasonably interpreted by the Examiner to be balloon **4** since balloon **4** is fully capable of being manually operated by hand compressions in order to deliver air to the inflatable chamber—connected to said inflatable chamber, said pump delivering air to said inflatable chamber when actuated, and a normally closed release valve **6** connected to said inflatable chamber, said release valve venting air from said inflatable chamber when manually actuated.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Toffolon (US 4,971,051) in view of Morgan (US 3,680,556). Toffolon teaches essentially all of the limitations except for a resilient open cell foam at least partially filling said inflatable

chamber. However, Morgan does teach the use of an open cell foam to prevent collapse of the cushion under increased pressure (column 4, lines 15-43). Therefore, it would have been obvious to one of ordinary skill in the art to provide an open cell foam in the inflatable chamber of Toffolon so that the cushion does not collapse under increased pressure.

***Allowable Subject Matter***

12. **Claims 7-10** are allowed.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese whose telephone number is 571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR
March 2, 2006

Henry Bennett
Supervisory Patent Examiner
Group 3700